

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Klein)	Examiner:	Brown, Vernal U.
)		
Serial No.:	10/694,582)	Art Unit:	2612
)		
Filed:	October 27, 2003)	Attorney Doc.:	81230.98US1
)		
Title:	Controlling Device Having)		
	Device Mode State)		
	Toggle Feature)		

SUBSTITUTE APPEAL BRIEF

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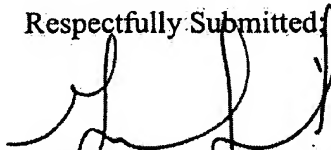
Dear Sir:

Appellant hereby submits this substitute Appeal Brief in response to the Notice of Non-Compliant Appeal Brief and in connection with the appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-28 and 30-50 which rejection was set forth in the Office Action mailed June 14, 2007. A timely Notice of Appeal was filed.

This Appeal Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted,



Date: October 23, 2007

By: Gary R. Jarosik, Reg. No. 35,906
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I. Real Party In Interest

The real party in interest is Universal Electronics Inc.

II. Related Appeals And Interferences

There are no known related appeals or interferences.

III. Status Of The Claims

In the application claims 1-28 and 30-50 remain pending and having been finally rejected are the subject of this appeal.

Claim 29 has been canceled without prejudice.

The Section VIII appendix provides a clean, double spaced copy of pending claims 1-28 and 30-50.

IV. Status Of Amendments

The claims are in condition for appeal – no amendments to the claims are pending.

V. Summary Of The Claimed Subject Matter

In accordance with 37 CFR § 41.37(c)(1)(v), the following provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal with reference to the specification by page and line number and to the drawings by reference characters:

Independent claim 1 is directed to a controlling device (100) having a plurality of device mode states (TV, DVD, RCVR, SAT, etc.) each of which is selectable to configure the controlling device to command operating functions of one or more of a plurality of different appliances (102, 104, 106, 108) defined for that device mode state (Page 11, lines 7-17). The controlling device (100) of independent claim 1 comprises:

programming responsive to receipt of a first input (110) for directly selecting one of the plurality of device mode states to thereby configure the controlling device (Fig. 7; Page 12, lines 14-22 or Fig. 8; Page 13, lines 10-14; Page 15, lines 8-18); and

programming responsive to receipt of a second input (111) for selecting, as a function of at least one of a one of the plurality of device mode states the controlling device (100) is in at a time the second input (111) is received and a one of the plurality of device mode states the controlling device (100) was placed into a last time the second input (111) was received one of a subset of the plurality of device mode states to thereby configure the controlling device (100) (Fig. 7, Page 12, lines 14-22 or Fig. 8; Page 13, lines 10-14; Page 15, lines 8-18).

Independent claim 25 is directed to a machine readable media (304, 305, 306) having embedded processor executable instructions for use in a controlling device (100) having a plurality of device mode states (TV, DVD, RCVR, SAT, etc.), each of which may be selected to configure the controlling device (100) to transmit command codes to one or more of a plurality of different appliances (102, 104, 106, 108) (Page 11, lines 7-17). The readable media of independent claim 25 has instructions for performing steps comprising:

accepting first input (110) that functions to directly select one of the plurality of device mode states to thereby configure the controlling device (100) (Fig. 7; Page 12, lines 14-22 or Fig. 8; Page 13, lines 10-14; Page 15, lines 8-18); and

accepting second input (111) that functions to select, as a function of at least one of a one of the plurality of device mode states the controlling device (100) is in at a time the second input (111) is accepted and a one of the plurality of device mode states the controlling device (100) was placed into a last time the second input (111) was accepted, one of a subset of the plurality of device mode states to thereby configure the controlling device (100) (Fig. 7; Page 12, lines 14-

22 or Fig. 8; Page 13, lines 10-14; Page 15, lines 8-18).

Independent claim 46 is directed to a method for use in a controlling device (100) having a plurality of device mode states (TV, DVD, RCVR, SAT, etc.) each of which may be selected to configure the controlling device (100) to transmit command codes to one or more of a plurality of different appliances (102, 104, 106, 108) (Page 11, lines 7-17). The method of independent claim 46 comprises:

receiving input (110, 111) for causing the controlling device (100) to change from a first device mode state selected from the plurality of device mode states to a second device mode state selected from the plurality of device mode states (Fig. 7; Page 12, lines 14-22); and

in response to the input (110, 111) being received placing the controlling device (100) into the second device mode state and storing (704) data indicative of the first device mode state in the controlling device (100) whereby the stored data is used by the controlling device (100) in connection with an actuation of a device mode state toggle key (111) of the controlling device to return the controlling device (100) to the first device mode state (Fig. 7; Page 12, lines 14-22).

Independent claim 50 is directed to method for use in a controlling device (100) having a plurality of device mode states (TV, DVD, RCVR, SAT, etc.) each of which may be selected to configure the controlling device (100) to transmit command codes to one or more of a plurality of different appliances (102, 104, 106, 108) (Page 11, lines 7-17). The method of independent claim 50 comprises:

receiving input for selecting a subset of the plurality of device mode states to create a circular list (840) of device mode states which is stored in a memory (305, 306) of the controlling device (100) such that input received from a single device mode state toggle key (111) will cause the controlling device (100) to change from a current device mode state selected

from the subset of the plurality of device mode states into another device mode state selected from the subset of the plurality of device mode states where the another device mode state follows the current device mode state within the circular list (840) of device mode states stored in the memory (305, 306) and wherein, in response to the change, the another device mode state becomes the current device mode state (Fig. 8; Page 13, lines 10-14; Page 15, lines 8-18).

VI. Grounds Of Rejection To Be Reviewed On Appeal

1. Whether the rejection of independent claims 1 and 25 (and, therefore, the rejection of dependent claims 2-7, 10-12, 14, 17-20, 24, 26-28, 30-36, 38, and 41-45) under 35 U.S.C. § 102 based upon Van Ryzin (U.S. Patent No. 6,127,941) can be maintained when Van Ryzin fails to disclose, teach, or suggest all of the elements set forth within the claims.

2. Whether the rejection of independent claim 46 (and, therefore, the rejection of dependent claims 47 and 48) under 35 U.S.C. § 102 based upon Lin (U.S. Patent No. 6,633,281) can be maintained when Lin fails to disclose, teach, or suggest all of the elements set forth within the claim.

3. Whether the rejection of independent claim 50 under 35 U.S.C. § 102 based upon Lin (U.S. Patent No. 6,633,281) can be maintained when Lin fails to disclose, teach, or suggest all of the elements set forth within the claim.

The Appellant is not requesting review of the rejection of dependent claims 8 and 9 under 35 U.S.C. § 103 in view of the combination of Van Ryzin and Lin, the rejection of dependent claims 13 and 37 under 35 U.S.C. § 103 in view of the combination of Van Ryzin and Tigwell, the rejection of claims 15, 16, 39, and 40 under 35 U.S.C. § 103 in view of the combination of Van Ryzin and Hashimoto, the rejection of claims 21 and 22 under 35 U.S.C. § 103 in view of

the combination of Van Ryzin and Griesau, or the rejection of dependent claim 49 under 35 U.S.C. § 103 in view of the combination of Lin and Tigwell as these dependent claims must be found to be allowable if the claims from which they depend are found to be allowable.

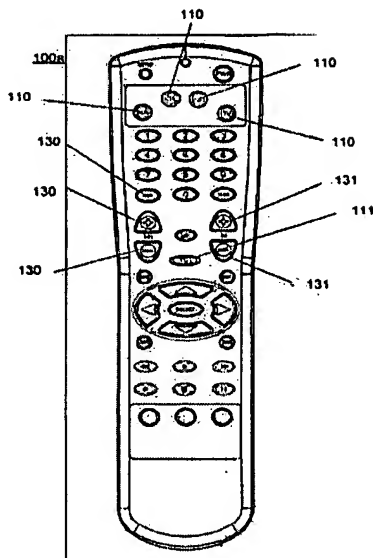
VII. Argument

A) Applicable Law

It is well settled that a rejection under 35 U.S.C. § 102 can be maintained only if each and every element as set forth in a claim is found, either expressly or inherently described, in the reference being relied upon. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, to maintain a rejection under 35 U.S.C. § 102, the identical invention must be shown in as complete detail in the reference being relied upon as is contained in the claim being considered. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

B) Van Ryzin Fails To Disclose All Of The Elements Of Claims 1 and 25

The invention set forth in independent claims 1 and 25 is directed, by way of example, to a controlling device (100) which includes a plurality of device mode keys (110 - e.g., TV, VCR, SAT, etc.) as well as a device mode toggle key (111). When one of the device mode keys (110) is actuated, programming of the controlling device (100) is responsive to *directly* select one of



the plurality of device mode states to thereby configure the controlling device (100). For example, the controlling device (100) is *directly* configured to a state for use in controlling a TV device in response to the corresponding TV device mode key (110) being actuated. Meanwhile, when the device toggle mode key (111) is actuated, programming of the controlling device (100) responds to configure the controlling device (100) to a mode for controlling a particular

device (e.g., TV, VCR, SAT, etc.) as a function of at least one of which device mode state the controlling device (100) is in at a time the device toggle mode key (111) is actuated and which device mode state the controlling device (100) was placed into a last time the device mode toggle key (111) was actuated. This operation of the controlling device is particularly illustrated in Figs. 7 and 8 of the subject application reproduced below.

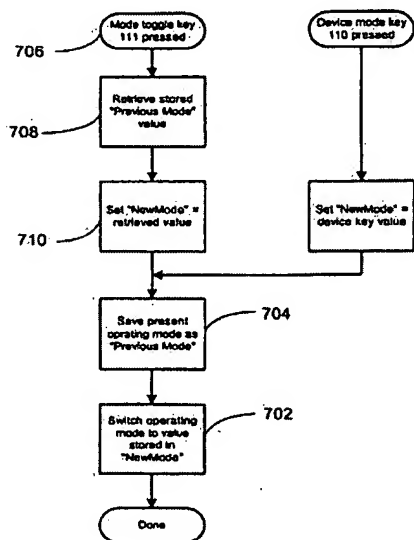


FIGURE 7

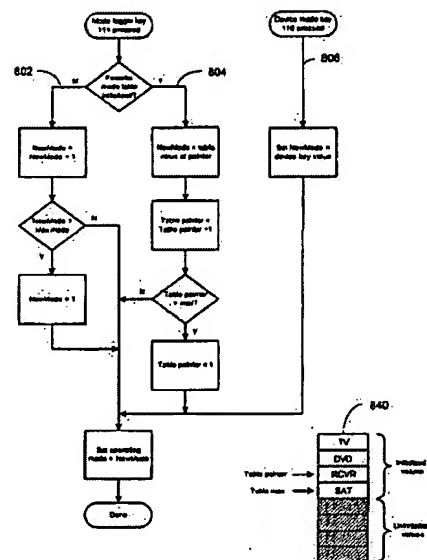


FIGURE 8

Considering now Van Ryzin, it is respectfully submitted that Van Ryzin discloses a remote control that presents to a user a plurality of dedicated device mode state selectors, e.g., a TV icon, a CD player icon, a stereo icon - *which correspond to the device mode keys 110 discussed above*, and the remote control of Van Ryzin is placed into a device mode state configuration, e.g., a device mode state configuration to control a TV, a CD player, or a stereo receiver, solely as a function of the one of the plurality of device modes state selectors ultimately selected by the user. (Col. 5, lines 20-4). Accordingly, it is respectfully submitted that Van Ryzin discloses nothing more than a remote control having dedicated device mode keys which are actuated to place the remote control *directly* into a corresponding device mode state, i.e., Van Ryzin discloses nothing more than the “device mode 110 pressed,” “set ‘newmode’ = device key value,” and “switch operating mode to value stored in ‘newmode’” steps of the flow charts of Figs. 7 and 8 above. While the Examiner is correct in noting that, once the device of Van Ryzin is placed into a device mode state via actuation of a device mode state selector (e.g., by selecting the TV icon) the remote control will select functions pertaining to the selected device mode state (e.g., cause the remote control to issue commands to control channel or volume functions of a TV as is the conventional end result of a remote control being placed into a TV device mode configuration), it is respectfully submitted that this disclosure within Van Ryzin does not equate to nor has any relevance to the claimed programming within a controlling device responsive to a receipt of an input (e.g., actuation of a device mode toggle key 111) for selecting, as a function of at least one of a one of the plurality of device mode states (e.g., TV, VCR, Aux, etc.) the controlling device is in at a time the input is received and a one of the plurality of device mode states (e.g., TV, VCR, Aux, etc.) the controlling device was placed into a last time the input was received, one of a subset of a plurality of device mode states (e.g., TV, VCR, Aux, etc.) to thereby

be used as the configuration for the controlling device.

For at least this reason it is respectfully submitted that Van Ryzin fails to anticipate or render obvious, considered alone or in combination with the remaining references of record, the invention recited in any of claims 1-28 and 30-45 and the rejection of these claims must be withdrawn.

C) Lin Fails To Disclose All Of The Elements Of Claim 46

The invention set forth in independent claim 46 is directed, by way of example, to a controlling device (100) which may include a plurality of device mode keys (110 - e.g., TV, VCR, SAT, etc.) and which includes a device mode toggle key (111). When one the device mode keys (110) - if any - or the device mode toggle key (111) is actuated, programming of the controlling device (100) is responsive to store data indicative of the device mode state (e.g., VCR, TV, SAT, etc.) being exited (*see* Fig. 7, 704 above) whereby the stored data is available for use by the controlling device (100) to determine in which device mode state the controlling device (100) is to be configured the next time the device mode state toggle key (111) is actuated (*see* Fig. 7, 708, 710, 702 above).

Considering now Lin, it is respectfully submitted that, like Van Ryzin, Lin discloses a remote control that presents to a user a plurality of dedicated device mode state selectors, e.g., a TV icon, a SAT icon, a DVD icon (as illustrated in Fig. 2 of Lin) - *which correspond to the device mode keys 110 discussed above*, and the remote control is placed into a device mode state configuration, e.g., a device mode state configuration to control a TV, a SAT receiver, a DVD player, *solely as a function* of the one of the plurality of device modes state selectors ultimately selected by the user. (Col. 4, lines 42-49). Thus, it is respectfully submitted that, like Van Ryzin, Lin discloses nothing more than a remote control having dedicated device mode keys which are

individually actuated to *directly* place the remote control into a corresponding device mode state, i.e., Lin, like Van Ryzin, discloses nothing more than the “device mode 110 pressed,” “set ‘newmode’ = device key value,” and “switch operating mode to value stored in ‘newmode’” steps of the flow chart of Figs. 7. While the Examiner is correct in noting that Lin also discloses that the remote control may include macro keys which, when actuated, will cause the remote control to execute a series of functions (i.e., transmit commands) that have been previously programmed into the remote control, i.e., programmed into the remote control prior to the macro key ever being activated, (Col. 4, lines 60-62; Col. 2, lines 10-22), it is respectfully submitted that this disclosure within Lin does not equate to nor has any relevance to the claimed controlling device method that responds to a receipt of an input used to change a remote control from a first device mode state to a second device mode state by placing the remote control into the second device mode state and storing data indicative of the first device mode state, i.e., the device mode state just left, whereby a subsequent activation of a device mode state toggle key allows for the return of the remote control to that saved, first device mode state.

For at least this reason it is respectfully submitted that Lin fails to anticipate or render obvious, considered alone or in combination with the remaining references of record, the invention recited in any of claims 46-49 and the rejection of these claims must be withdrawn.

D) Lin Fails To Disclose All Of The Elements Of Claim 50

The invention set forth in independent claim 50 is directed, by way of example, to a controlling device (100) which may include a plurality of device mode keys (110 - e.g., TV, VCR, SAT, etc.) and which includes a device mode toggle key (111). The user may interact with the device mode keys (110) to create a circular list (840) of device mode states which are stored within the memory of the controlling device. When the user actuates the device mode

toggle key (111) the controlling device (100) will be caused (*see* Fig. 8, 804 above) to change from the current device mode state to another device mode state where the another device mode state selected for use in configuring the controlling device (e.g., SAT) is the device mode state that follows the current device mode state (e.g., RCVR) within the circular list (804).

As discussed above, it is respectfully submitted that Lin discloses nothing more than a remote control having dedicated device mode keys which are individually actuated to *directly* place the remote control into a corresponding device mode state, i.e., Lin, like Van Ryzin, discloses nothing more than the “device mode key 110 pressed,” “set ‘newmode’ = device key value,” and “set operating mode = ‘newmode’” steps of the flow chart of Figs. 8. As also discussed above, while the Examiner is correct in noting that Lin also discloses that the remote control may include macro keys which, when actuated, will cause the remote control to execute a series of functions (i.e., transmit commands) that have been previously programmed into the remote control, i.e., programmed into the remote control prior to the macro key ever being activated, (Col. 4, lines 60-62; Col. 2, lines 10-22), it is respectfully submitted that this disclosure within Lin does not equate to nor has any relevance to the claimed controlling device method that stores in memory a circular list of device mode states whereby activation of a single device mode state toggle key is used to place the controlling device into a device mode state as indicated by a current position within the circular list of device mode states.

For at least this reason, it is respectfully submitted that Lin fails to anticipate or render obvious, considered alone or in combination with the remaining references of record, the invention recited in claim 50.

E) Conclusion

For all of the reasons set forth above it is respectfully submitted that the application is in

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good and proper form for allowance. Such action of the part of the Office is respectfully requested.

VIII. Claims Appendix

The following is a clean copy of the claims involved in the appeal:

1. A controlling device having a plurality of device mode states each of which is selectable to configure the controlling device to command operating functions of one or more of a plurality of different appliances defined for that device mode state, the controlling device comprising:

programming responsive to receipt of a first input for directly selecting one of the plurality of device mode states to thereby configure the controlling device; and

programming responsive to receipt of a second input for selecting, as a function of at least one of a one of the plurality of device mode states the controlling device is in at a time the second input is received and a one of the plurality of device mode states the controlling device was placed into a last time the second input was received one of a subset of the plurality of device mode states to thereby configure the controlling device.

2. The controlling device as recited in claim 1, wherein the second input comprises actuation of a device mode state toggle key of the controlling device.

3. The controlling device as recited in claim 1, wherein the subset of the plurality of device mode states is maintained in a table stored in a memory of the controlling device.

4. The controlling device as recited in claim 1, wherein the subset of the plurality of device mode states comprises one or more device mode states selected from the plurality of device mode states by a user.

5. The controlling device as recited in claim 4, wherein the subset of the plurality of device mode states is selected by a user interacting with the programming responsive to receipt of a second input.
6. The controlling device as recited in claim 1, wherein the first input comprises actuation of one of a plurality of device mode keys of the controlling device each of which corresponds to one of the plurality of device mode states.
7. The controlling device as recited in claim 1, wherein the first input comprises selection of a device mode state from a menu of the controlling device having entries corresponding to each of the plurality of device mode states.
8. The controlling device as recited in claim 1, wherein the programming responsive to receipt of a second input additionally causes each of the device mode states within the subset of the plurality of device mode states to be selected in a predefined order.
9. The controlling device as recited in claim 8, wherein the predefined order is user selectable.
10. The controlling device as recited in claim 1, wherein the plurality of device mode states comprises only those device mode states of the controlling device that have been setup to cause the controlling device to be configured to command the operation of one or more appliances.

11. The controlling device as recited in claim 1, wherein each of the plurality of device mode states has an indicia that is presented when that device mode state is selected.
12. The controlling device as recited in claim 11, wherein the indicia comprises a color.
13. The controlling device as recited in claim 11, wherein the indicia comprises an illuminated LED.
14. The controlling device as recited in claim 11, wherein the indicia comprises a graphical representation.
15. The controlling device as recited in claim 11, wherein the indicia comprises a sound.
16. The controlling device as recited in claim 11, wherein the indicia comprises a vibration.
17. The controlling device as recited in claim 11, wherein the first input comprises actuation of one of a plurality of device mode keys of the controlling device each of which corresponds to one of the plurality of device mode states and wherein the indicia is associated with the plurality of device mode keys.
18. The controlling device as recited in claim 17, wherein the indicia comprises a means for presenting a device mode key with an appearance that is distinguishable from the remaining plurality of device mode keys.

19. The controlling device as recited in claim 18, wherein the indicia comprises a device mode key being illuminated.

20. The controlling device as recited in claim 2, wherein the device mode state toggle key is spaced from a top of the controlling device.

21. The controlling device as recited in claim 20, wherein the device mode state toggle key is located in a position adjacent to volume function command keys and channel function command keys of the controlling device.

22. The controlling device as recited in claim 20, wherein the device mode state toggle key is located in a position adjacent to menu navigation command keys of the controlling device.

23. The controlling device as recited in claim 2, wherein actuation of the device mode state toggle key causes the controlling device to be placed into one of two alternating device mode states.

24. The controlling device as recited in claim 23, wherein the alternating device mode states comprise a current device mode state and a device mode state exited to enter the current device mode state.

25. A machine readable media having embedded processor executable instructions for use in a

controlling device having a plurality of device mode states each of which may be selected to configure the controlling device to transmit command codes to one or more of a plurality of different appliances, the readable media having instructions for performing steps comprising:

accepting first input that functions to directly select one of the plurality of device mode states to thereby configure the controlling device; and

accepting second input that functions to select, as a function of at least one of a one of the plurality of device mode states the controlling device is in at a time the second input is accepted and a one of the plurality of device mode states the controlling device was placed into a last time the second input was accepted, one of a subset of the plurality of device mode states to thereby configure the controlling device.

26. The readable media as recited in claim 25, wherein the second input comprises actuation of a device mode state toggle key of the controlling device.

27. The readable media as recited in claim 25, wherein the instructions store the subset of the plurality of device mode states in a table stored in a memory of the controlling device.

28. The readable media as recited in claim 25, wherein the instructions accept input whereby a user selects which of the plurality of device mode states to include within the subset of the plurality of device mode states.

30. The readable media as recited in claim 25, wherein the first input comprises actuation of a corresponding one of a plurality of device mode keys of the controlling device each of which

corresponds to one of the plurality of device mode states.

31. The readable media as recited in claim 25, wherein the first input comprises selections from a graphical user interface menu of the controlling device having entries corresponding to each of the plurality of device mode states.

32. The readable media as recited in claim 25, wherein the instructions additionally cause one of the subset of the plurality of device mode states to be selected in a predefined order.

33. The readable media as recited in claim 32, wherein the predefined order is user selectable.

34. The readable media as recited in claim 25, wherein the plurality of device mode states comprises only those device mode states of the controlling device that have been setup to cause the controlling device to be configured to command the operation of one or more appliances.

35. The readable media as recited in claim 25, wherein the instructions present an indicia representative of a device mode state when that device mode state is selected.

36. The readable media as recited in claim 35, wherein the indicia comprises a color.

37. The readable media as recited in claim 35, wherein the indicia comprises an illuminated LED.

38. The readable media as recited in claim 35, wherein the indicia comprises a graphical representation.

39. The readable media as recited in claim 35, wherein the indicia comprises a sound.

40. The readable media as recited in claim 35, wherein the indicia comprises a vibration.

41. The readable media as recited in claim 35, wherein the first input comprises actuation of one of a plurality of device mode keys of the controlling device each of which corresponds to one of the plurality of device mode states and wherein the indicia is associated with the plurality of device mode keys.

42. The readable media as recited in claim 41, wherein the indicia comprises a means for presenting a device mode key with an appearance that is distinguishable from the remaining plurality of device mode keys.

43. The readable media as recited in claim 42, wherein the indicia comprises a device mode key being illuminated.

44. The readable media as recited in claim 26, wherein actuation of the device mode state toggle key causes the instructions to place the controlling device into one of two alternating device mode states.

45. The readable media as recited in claim 44, wherein the alternating device mode states comprise a current device mode state and a device mode state exited to enter a current device mode state.

46. For use in a controlling device having a plurality of device mode states each of which may be selected to configure the controlling device to transmit command codes to one or more of a plurality of different appliances, a method comprising:

receiving input for causing the controlling device to change from a first device mode state selected from the plurality of device mode states to a second device mode state selected from the plurality of device mode states; and

in response to the input being received placing the controlling device into the second device mode state and storing data indicative of the first device mode state in the controlling device whereby the stored data is used by the controlling device in connection with an actuation of a device mode state toggle key of the controlling device to return the controlling device to the first device mode state.

47. The method as recited in claim 46, wherein the input comprises actuation of the device mode state toggle key.

48. The method as recited in claim 46, wherein the input comprises actuation of one of a plurality of device mode keys of the controlling device each representing one of the plurality of device mode states.

49. The method as recited in claim 48, comprising illuminating the device mode key representing the second device mode state.

50. For use in a controlling device having a plurality of device mode states each of which may be selected to configure the controlling device to transmit command codes to one or more of a plurality of different appliances, a method comprising:

receiving input for selecting a subset of the plurality of device mode states to create a circular list of device mode states which is stored in a memory of the controlling device such that input received from a single device mode state toggle key will cause the controlling device to change from a current device mode state selected from the subset of the plurality of device mode states into another device mode state selected from the subset of the plurality of device mode states where the another device mode state follows the current device mode state within the circular list of device mode states stored in the memory and wherein, in response to the change, the another device mode state becomes the current device mode state.

IX. Evidence Appendix

No evidence is being submitted herewith.

X. Related Proceedings Appendix

No copies of decisions rendered by a court or the Board are being submitted herewith.

CHI 56806564v2.